



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,223	11/18/2003	Takahiro Nakajima	11197/5	3150

23838 7590 09/10/2004

KENYON & KENYON  
1500 K STREET, N.W., SUITE 700  
WASHINGTON, DC 20005

EXAMINER
----------

PASTERCZYK, JAMES W

ART UNIT	PAPER NUMBER
----------	--------------

1755

DATE MAILED: 09/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/830,223

Applicant(s)

NAKAJIMA ET AL.

Examiner

J. Pasterczyk

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-49 and 68-76 is/are pending in the application.
- 4a) Of the above claim(s) 2,3,49 and 68-76 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 2-49 and 68-76 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5/18/04, 4/29/04, 12/29/03
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

1. This Office action is in response to the response of 6/25/04.

2. Applicant's election with traverse of group II, claims 4-48 in the reply filed on 6/25/04 is acknowledged. The traversal is on the ground(s) that there would have been no further burden to search the other inventions. This is not found persuasive because the other inventions are found in different classes and subclasses than those of the selected invention and are normally the province of a different work group of examiners.

The requirement is still deemed proper and is therefore made FINAL.

3. The abstract of the disclosure is objected to because it refers to the purported merits of the invention as well as to the non-elected and non-rejoinable claims. Correction is required. See MPEP § 608.01(b).

4. Claims 4-48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In each claim, first line, "polyester polymerization catalyst" is an oxymoron since the catalyst does not polymerize polyesters but instead diols and acids to make polyesters.

Claim 12 appears to be redundant with claim 11 except for the deletion of one metal. Likewise claims 15 and 16 and claims 17 and 18.

In claim 23, tellurium and boron are not metals, hence they cannot be the metals of the "metal-containing component".

In claim 26, the two formulas recited are not necessarily aniline or phenol derivatives unless at least one instance of X or X<sub>2</sub> is hydrogen, hence the preamble is inconsistent with the body of the claim. Where applicant acts as his or her own lexicographer to specifically define a

Art Unit: 1755

term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term “Y” in claim 26 is used by the claim to mean “direct bond etc”, while the accepted meaning is “yttrium.” The term is indefinite because the specification does not clearly redefine the term. Since the claims use yttrium as a metal for the metal-containing component, this issue is not addressed properly by redefining Y in the claims as the direct bond etc. found therein. These problems also exist in claims 27-36.

Further in claim 27, 8<sup>th</sup> line below the structures both subscripted and unsubscripted coefficients are given for the carbon atoms.

Further in claim 28, if n is in the range of about 1-3 it is not clear what structure would actually be formed since these values of n would seem to result in extreme ring strain.

In claims 37, 38 and 40-48, delete the indefinite articles before the names of the various compounds since the structures are of the compounds named and are not species of a family.

In claim 43 neither of the structures recited has nitrogen in it, hence neither can be a subgroup of formula 4.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 4-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Y<sub>ou</sub> et al., USP 5,260,246 (hereafter referred to as Yuo).


Art Unit: 1755

Yuo discloses the invention as claimed (col. 3, l. 49 to col. 4, l. 14).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Pasterczyk whose telephone number is 571-272-1375. The examiner can normally be reached on M-F from 9 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell, can be reached at 571-272-1362. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Mark L. Bell  
Supervisory Patent Examiner  
Technology Center 1700



J. Pasterczyk

AU 1755

9/5/04